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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,892	12/15/2003	Richard S. Kirby	1892.0	4487
22497	7590	10/06/2005	EXAMINER	
LARSON AND LARSON 11199 69TH STREET NORTH LARGO, FL 33773			IQBAL, KHAWAR	
			ART UNIT	PAPER NUMBER
			2686	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,892

Applicant(s)

KIRBY, RICHARD S.

Examiner

Khawar Iqbal

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6-21-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, drawn to a method for call routing, classified in class 455, subclass 445.
- II. Claims 13-16, drawn to a method for billing, classified in class 455, subclass 406.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because calls routing. The subcombination has separate utility such as billing.

2. During a telephone conversation with Mr. H. Larson on 9-19-05 a provisional election was made without traverse to prosecute the invention of I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-16 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 are rejected under 35 U.S.C. 102(e) as being unpatentable by Tornkvist (20050090247).

5. Regarding **claim 1** Tornkvist teaches a method of choosing which long distance company a wireless roamer uses based on the selection of the wireless roamer or its home wireless carrier comprising (figs. 1-9):

(1) sending a plurality of transaction capabilities application part messages between a wireless service control point and a wireless switching center, comprising the steps of: (i) sending transaction capabilities application part message that validate a

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roamer (ii) Instruct the service mobile switch center to pass dialed number information and (para. # 0047,0050-0053);

(2) routing of the call to an interactive voice response until to play a brief recorded message and (para. # 0047,0050-0053);

(3) routing of the wireless call to the called party (para. # 0047,0050-0053).

Regarding **claim 2** Tornkvist teaches wherein the wireless parameters comprise: a mobile switching center identification number (para. # 0055-0056).

Regarding **claim 3** Tornkvist teaches a number dialed by a caller; and a mobile switching center identification number (para. # 0055-0056).

Regarding **claim 4** Tornkvist teaches wherein step (2) comprises: (i) receiving the number dialed by the wireless subscriber and; (ii) determine if it is a long distance call and; (iii) sending instructions to the mobile switching center to change the call routing to the interactive voice response unit via an Public Switched Telephone Network (para. # 0047,0050-0053, 0028,0030).

Regarding **claim 5** Tornkvist teaches wherein step (2) comprises: (i) creating a table which will indicate by mobile switching center whether a dialed call is a long distance; (ii) activating the serving mobile switching center to send dialed digits before a wireless call is routed sending the initial address message with the mobile identification number (para. # 0047,0050-0053).

Regarding **claim 6** Tornkvist teaches further comprising the following steps that are performed before step (1); sending a query for one or more roaming parameters from a serving wireless mobile switching center to a home location register (HLR); and

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sending one or more roaming parameters from the home location register to the subscriber's home mobile switching center (para. # 0047,0050-0053, 0030,0056).

Regarding **claim 7** Tornkvist teaches wherein said roaming parameters comprise: a mobile identification number (para. # 0055-0056).

Regarding **claim 8** Tornkvist teaches wherein said roaming parameters comprise: a phone number dialed by the wireless subscriber (para. # 0055-0056).

Regarding **claim 9** Tornkvist teaches further comprising the following steps that are performed before step (1): signaling from a telephone to a local network; signaling from the local network to a mobile switching center; sending a query for one or more roaming parameters from the mobile switching center to a home location register; and sending the roaming parameters from the home location register to the serving mobile switching center (para. # 0047,0050-0053, 0030,0056).

Regarding **claim 10** Tornkvist teaches (3) signaling from the mobile switching center to an Public Switched Telephone Network; (4) signaling from the Public Switched Telephone Network to a mobile switching center; and (5) signaling from the mobile switching center to a wireless handset (para. # 0047,0050-0053, 0030).

Regarding **claim 11** Tornkvist teaches wherein the mobile switching center is instructed to send only inter-lata (long distance) toll calls (para. # 0047,0050-0053).

Regarding **claim 12** Tornkvist teaches wherein the mobile switching center is instructed to send information to a different home location register at call startup (para. # 0047,0050-0053, 0030).

Conclusion


6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Khawar Iqbal whose telephone number is (571) 272-7909.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Khawar Iqbal


CHARLES APPIAH
PRIMARY EXAMINER